



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/701,883

11/05/2003

Nabil L. Muhanna

49272.830034.US2

6707

70818 7590 08/29/2008
Holland & Hart, LLP (LANX, Inc.)
Intellectual Property Department
P.O. Box 8749
Denver, CO 80201-8749

EXAMINER

PRONE, CHRISTOPHER D

ART UNIT

PAPER NUMBER

3738

MAIL DATE

DELIVERY MODE

08/29/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/701,883	Applicant(s) MUHANNA ET AL.	
	Examiner CHRISTOPHER D. PRONE	Art Unit 3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-13,15,16,18,20-23,25-30,41-45 and 48-50 is/are pending in the application.
- 4a) Of the above claim(s) 13,16,22,23,25,27-30,41-45 and 311 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,6-10,15,18,20,21,26 and 48-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The earliest support for the elected embodiment of this application is in provisional application 60476075. Therefore the priority date of this application is 6/5/03.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 4, 6-10, 15, 18, 20, and 48-50 are rejected under 35 U.S.C. 102(e) as being anticipated by United States Patent 6,890,355 Michelson et al.

Michelson discloses a metal vertebral body replacement comprising a body 300, nonparallel top and bottom surfaces (shown best in figure 17) having a plurality of through holes and continuous grooves 314 and protrusions (5:62-65), two growth hole faces 310 (planar) and 312 (curved) having 4 through holes 319 and a curves anterior face 304. Michelson further discloses use of a second identical implant for insertion along side the first 300".

In regards to claim 2 the grooves on the top surface extend completely through a portion of the top surface.

Art Unit: 3738

In regards to claims 48-50 Michelson discloses a plurality of grooves that extend perpendicular to the posterior surface. The first groove on the top is clearly not aligned in the same plane as with the last groove on the bottom.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 21 is rejected under 35 U.S.C. 103 as being unpatentable over Michelson in view of United States Patent Paul et al 6,143,033.

Michelson discloses the invention substantially as claimed being described above. However, Michelson fails to disclose making his device from the bone comprising the medullary cavity.

Paul teaches the use of an implant made from bone comprising medullary cavity in the same field of endeavor for the purpose of using natural materials that the body will accept and grow into.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the bone material taught by Paul with the device of Michelson in order to provide an implant made from all natural materials.

Claim 26 is rejected under 35 U.S.C. 103 as being unpatentable over Michelson in view of United States Wagner et al 5,306,309.

Michelson discloses the invention substantially as claimed being described above. However, Michelson fails to disclose making his device from a plurality of bonded layers.

Wagner teaches the use of an implant comprising a base metal having layers bonded to its outer surface in the same field of endeavor for the purpose enhancing the implants material properties. (6:13-40)

It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the implant of Michelson out of a plurality of layers as taught by Wagner in order to provide an implant with enhanced durability or porosity.

Response to Arguments

For clarity sake the correct patent number has been listed in the 102 rejection above and claim number 19 has been removed from the rejection.

Applicant's arguments filed 6/30/08 have been fully considered but they are not persuasive. The applicant bases his arguments upon two components shown in figure 14 of Michelson. However the rejection is based upon a single implant, which reads upon the subject matter of the claims. Since the two implants of Michelson are not connected they are able to be inserted separately or independently, which reads on the subject matter of the claims. The applicant then argues that Michelson fails to disclose two growth hole faces, but the rejection clearly outlines both planar bone hole face 310

Art Unit: 3738

and curved bone hole face 312. The rejection is clear and accurate so this action is being made final.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRISTOPHER D. PRONE whose telephone number is (571)272-6085. The examiner can normally be reached on Monday through Fri 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone

Art Unit: 3738

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Christopher D Prone
Examiner
Art Unit 3738

/Christopher D Prone/
Examiner, Art Unit 3738

/Corrine M McDermott/

Supervisory Patent Examiner, Art Unit 3738